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### REMARKS

Entry of this response and reconsideration and allowance of the above-identified patent application are respectfully requested. Claims 1-20 were rejected in the Office Action. Upon entry of this amendment and response, claims 1-20 will be pending in the application. No new matter has been added, and no additional prior art searches are required by the amendments.

In the official action, claims 1-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Muntz *et al.* (U.S. Patent No. 5,896,427) ("Muntz") in combination of Khasnabish (U.S. Patent No. 6,411,679). Applicants respectfully assert that claims 1-20 are distinguished over the teachings of Muntz and Khasnabish for the reasons given below.

As acknowledged by the office action, "Muntz does not explicitly show testing a communication network." To overcome the limitation in Muntz, the office action relies on Khasnabish's teaching of a call progress timing measurement for Internet protocol (IP) telephony. However, with all due respect to the contention in the office action, the addition of Khasnabish with Muntz does not meet the present invention.

The present invention provides, *inter alia*, a method for testing a communication network using a first clock and a second clock that operate from a substantially similar reference. In particular, a first signal is transmitted from a first point to a remotely located second point. The

first clock time stamps the signal as it is transmitted from the first point, and the second clock time stamps the signal as it is received at the second point.

Muntz in combination with Khasnabish do not meet the limitations of the present invention. In particular, Khasnabish does not teach or suggest providing network testing based on separate clocks that operate from a substantially similar reference. Quite the contrary, Khasnabish teaches away from the present invention by disclosing a testing method that uses a single clock to “calculate an elapsed time between sending the signal and receiving *a response to the signal*.” (*Khasnabish* – column 1, lines 56-60) (emphasis added). More specifically, Khasnabish has a first device that sends a signal to a second device. The first device then waits for a response from the second device and adjusts an answer tone accordingly. (*Khasnabish* – column 1, lines 55-58). In other words, Khasnabish records the transmission time and the reception time using a single clock, located with the first device.

It therefore follows that Khasnabish does not require providing separate clocks at different locations that operate from a substantially similar reference, as with the present invention, because Khasnabish’s test signal is being sent from and received back at the same location (*i.e.*, the first device).

Accordingly, withdrawal of the rejection of claims 1-20 under 35 U.S.C. §103(a) as being obvious over Muntz in view of Khasnabish is believed proper and respectfully solicited.

In addition, applicant believes that the office action failed to establish a *prima facie* case of obviousness. Even assuming, *arguendo*, that the claimed invention is within the capabilities of one of ordinary skill in the art, such fact is not by itself, sufficient to establish a *prima facie* case of obviousness. *M.P.E.P.* § 2143.01. “The prior art must provide a motivation or reason for the worker in the art, *without the benefit of [the applicant’s] specification*, to make the necessary changes in the reference device.” *M.P.E.P.* § 2144.04 (citing *Ex parte Chicago Rawhide Manufacturing Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). In particular, “[a] critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). To establish a *prima facie* case of obviousness, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). “In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Here, applicant respectfully asserts that the neither Muntz nor Khasnabish provide specific guidance that would lead one of ordinary skill in the art to the present invention.

Therefore, the office action failed to establish a *prima facie* case of obviousness.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**Marked up version of claim 13, which is amended herein, showing all of the changes relative to the previous version.**

- 13. (Amended) A system for testing a communication network, comprising:
  - a signal generator for providing a first signal to said communication network;
  - a first clock device coupled to said signal generator, wherein said first clock device records a first time said first signal is provided to said communication network;
  - a signal receiver for receiving a second signal from said communication network;
  - and
  - a second clocking device coupled to said signal receiver, wherein said second clock device records a second time said second signal is received from said communication network[;],
- wherein said first and second clocking devices operate from a substantially similar reference.
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